



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,085	04/24/2001	Alanna Schepartz Shrader	YU-P01-021	2186
28120	7590	06/01/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			ALLEN, MARIANNE P	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,085

Applicant(s)

SHRADER ET AL.

Examiner

Marianne P. Allen

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-13, 19, 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5 and 12-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1647

DETAILED ACTION

Claims 1-5, 12-13, 19, and 23-27 are under consideration by the examiner.

Applicant is advised that the examiner has examined the claims with respect to SEQ ID NOS. 23-29. No other sequences are under consideration and the claims have only been examined to the degree that they reflect SEQ ID NOS: 23-29.

Applicant's arguments filed 3/15/06 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

This application contains claims 14-18 and 20-22 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

Claims 1-5, 12-13, 19, and 23-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NOS: 23-29 does not reasonably provide enablement for avian pancreatic polypeptides with the stated substitutions and properties. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This rejection is maintained for reasons of record.

Art Unit: 1647

Applicant argues at page 9 of the response that “one of skill in the art would readily understand that the term ‘avian pancreatic polypeptide’ means the unique aPP protein.” This assertion is not supported by any evidence nor is it agreed with by the examiner. There is no limiting definition in the specification for this phrase as being a particular protein and thus one of ordinary skill in the art must interpret the claim using the plain meaning of the words. The plain meaning of the phrase is any polypeptide found in a pancreatic tissue from an avian species. Applicant is reminded that during examination the claims are given their broadest reasonable interpretation. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.

Applicant’s arguments with respect to page 38 and peptides of SEQ ID NOS: 27, 28, and 29 binding Bcl are not persuasive. This section does not make clear that these particular peptides bind and Figure 4 provides no K_d for them.

Applicant’s response does not identify where within SEQ ID NO: 6 the sequences represented by SEQ ID NOS: 23-29 are present.

The claims remain an invitation to experiment and would constitute undue experimentation in view of the lack of guidance and unpredictability in the art.

Claim Rejections - 35 USC § 102

Claims 1-5, 12-13, 23, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Chittenden et al. (U.S. Patent No. 5,656,725).

This rejection is maintained for reasons of record.

As set forth above, there is no limiting definition in the specification for the phrase “avian pancreatic polypeptide” as being a particular protein and thus one of ordinary skill in the art must interpret the claim using the plain meaning of the words. The plain meaning of the phrase is any polypeptide found in a pancreatic tissue from an avian species. Applicant is reminded that during examination the claims are given their broadest reasonable interpretation. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.

Claim Rejections - 35 USC § 103

Claims 1-5, 12-13, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zondlo et al. (J. Am. Chem. Soc., 121:6938-939, 1999) in view of Sattler et al. (Science, 275:983-986, 1997).

This rejection is maintained for reasons of record and as discussed above with respect to the meaning of “avian pancreatic polypeptide.”

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

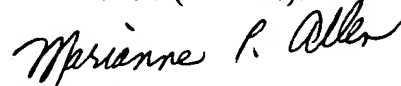
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1647

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Marianne P. Allen". The signature is written in a cursive, flowing style.

Marianne P. Allen
Primary Examiner
Art Unit 1647

mpa